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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Rogan, et al. Appeal No. 2007-2879
Serial No.: 09/924,372
Filed: 08/08/2001
Group Art Unit: 3621
Examiner: Bayat, Bradley B.
For: METHOD AND SYSTEM FOR ELECTRONICALLY
PROCESSING TRANSACTIONS

REQUEST FOR REHEARING
PURSUANT TO 37 CFR §41.52

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
Facsimile No. 571-273-0052

Dear Sir:

Appellants respectfully request rehearing for the Board to reconsider the decision in this appeal dated November 16, 2007. Appellants respectfully submit that the Board's decision is based upon an incorrect assumption regarding the teachings of the *Savino* reference, which led to an incorrect conclusion regarding the issue whether the *Savino* reference teaches away from the Examiner's proposed modification of that reference.

On page 7 of the Decision, the Board states, "We disagree with Appellants' contention that Savino's disclosure teaches *only* information input by the customer is linked to the bar code. Furthermore, we disagree with Appellants' contention that "the *Savino* reference is very protective of what information gets linked to the barcode of that reference" (Appeal Br. 16)." (Emphasis in original)

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The basis for the Board disagreeing with Appellants in those regards is explained on page 8 of the decision.

Appellants contend that because Savino discloses that there is no re-entry of purchase order information into the database of the supplier that only customer-inputted information is linked to the barcode. However, this is contrary to the disclosure of Savino which teaches that part of the information linked to the barcode is the shipping date (Finding of Fact 4 and Fig. 5 of Savino). Shipping date is generally not provided in the purchase order information supplied by the customer. (Emphasis in original)

Appellant respectfully submits that the above conclusion by the Board is incorrect and that the *Savino* reference does teach that only the customer enters the information including the "shipping date." Column 4, beginning at line 5 of the *Savino* reference states:

The customer is prompted by the web site to initially select items provided on the web site 19 in which the customer is interested in purchasing by entering purchase and shipping information such as customer name and address, and part numbers and quantities of the initially selected items (step 406). The supplier digital processor 12 continually monitors the same web site or page(s) and transmits to the customer digital processor 16 via the web site 19 which of the initially selected items is ready for *immediate shipment* (step 408). The customer then transmits an authorization command via the web site 19 to inform the supplier digital processor 12 that there is authorization for *immediate shipment* of the selected part (step 410). The supplier digital processor 12, upon receiving the authorization command, assigns a bar code and generates a bar code shipping label (step 412). The bar code links in the database 14 or supplier digital processor 12 a plurality of predetermined relevant purchase and shipping information *entered by the customer* and associated with a purchase order. (Column 4, lines 5-23) (Emphasis added)

The proper interpretation of the *Savino* reference to be consistent with the above-quoted description is that the shipping date information is based upon the customer's entry of information. As indicated above, the customer is provided with information regarding products that are available for immediate shipment and the customer provides

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an authorization command authorizing immediate shipment of those products. In other words, the *Savino* reference teaches that the shipping date will be the date of the customer's order (i.e., no later shipping date information need be entered by a supplier, for example). There is nothing in the *Savino* reference that justifies interpreting it in a manner that is inconsistent with the express teachings of the reference.

Moreover, column 4, lines 45-46 state, "purchase and *shipping* information is *only* entered by the customer." (Emphasis added) That is an unequivocal and express teaching that the customer is the only one entering information that constitutes purchase or shipping information as those terms are used in the *Savino* description.

Therefore, Appellants respectfully submit that the decision of the Board was in error because it relied upon an incorrect assumption regarding the shipping date information of the *Savino* reference. Appellants respectfully submit that the decision should be changed and the conclusion drawn that the *Savino* reference expressly teaches that only the customer enters information linked to the barcode of that reference.

It follows that the *Savino* reference teaches away from an arrangement where someone else would link information to the barcode. The *Savino* reference expressly teaches that only the customer enters such information. Appellants respectfully submit that a person of ordinary skill, upon reading *Savino's* express teaching to have only a customer link information to a barcode, would be led in a direction divergent from the path that was taken by Appellants. In other words, the *Savino* reference teaches away from the proposed modification that the Examiner intends to make to the *Savino* reference in order to manufacture a *prima facie* case of obviousness. Appellants respectfully submit that there can be no *prima facie* case of obviousness because of

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Savino's own express teachings limiting the source of information linked to the bar code of that reference to the customer exclusively.

Appellants respectfully submit that the Board's conclusion that, "Furthermore, nowhere in *Savino* is there any disclosure that linking status information is prohibited and nowhere does *Savino* discourage a supplier from subsequently linking status information to the barcode," should also be reconsidered and changed. Appellants respectfully submit that the express teachings of the *Savino* reference do prohibit (and at a bare minimum – discourage) any information being linked to the barcode other than the information provided by the customer. The express teaching that only the customer provides information linked to the barcode cannot be ignored. Only hindsight reasoning after having Appellants' disclosure in hand would provide any justification for ignoring (or perhaps, at best, parsing) *Savino's* express teachings limiting the source of information to the customer. Hindsight reasoning is not permitted when attempting to determine whether a *prima facie* case of obviousness can be established. In this case, where the *Savino* reference expressly teaches allowing only the customer to provide information that is linked to a barcode, the only possible justification for attempting to modify the *Savino* reference as done by the Examiner is hindsight reasoning based upon the benefit of already having read Appellants' disclosure.

Appellants respectfully request the Board to reconsider the decision of November 16, 2007 and to issue a new decision in Appellants' favor reversing all rejections made by the Examiner. There is no *prima facie* case of obviousness against any of Appellants' claims.

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The Commissioner is authorized to charge Deposit Account No. 08-0385 in the name of Hamilton Sundstrand for any fees that are due or credit the account for any overpayment.

Respectfully submitted,

CARLSON, GASKEY & OLDS

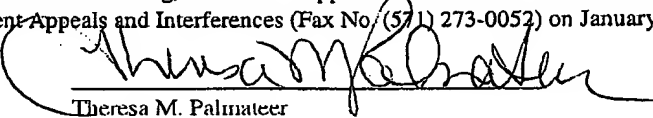
By: 

David J. Gaskey
Registration No. 37,139
400 W. Maple Rd., Ste. 350
Birmingham, MI 48009
(248) 988-8360

Dated: January 16, 2008

CERTIFICATE OF FACSIMILE

I hereby certify that this Request for Rehearing, relative to Application Serial No. 09/924,372 is being facsimile transmitted to the Board of Patent Appeals and Interferences (Fax No. (571) 273-0052) on January 16, 2008.


Theresa M. Palmateer

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